

REMARKS

Claims 1-7, 10-16, 19-25, 28-38, and 41-45 remain in this application. Claims 8, 9, 17, 18, 26, 27, 39, and 40 have been canceled. Claims 46-51 have been added.

I. CLAIM REJECTIONS – 35 USC § 102

A. Examiner's Statements

The examiner rejected Claims 1, 2, 5, 7, 10, 11, 13, 14, 19, 20, 23, 25, 28, 29, 32, 35, 36, 44, 46, 47, 49, and 50 under 35 U.S.C. § 102(b) as being anticipated by Carroll (U.S. Patent No. 4,951,749) ("Carroll").

B. Law

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ The identical invention must be shown in as complete detail as is contained in the ... claim.² To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."³ Thus, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.⁴ In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁵ In addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention.⁶

¹ *Verdegaal Bros v Union Oil Co of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

³ *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

⁴ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

⁵ *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

⁶ *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

C. Claims 1, 2, 5, 7, 10, 11, 13, 14, 19, 20, 23, 25, 28, 29, 32, 35, 36, 44, 46, 47, 49, and 50

Claims 1, 2, 5, 7, 10, 11, 13, 14, 19, 20, 23, 25, 28, 29, 32, 35, 36, 44, 46, 47, 49, and 50 of the present application require a retainer wall configured to retain at least a portion of the expandable material that is expanded when sealed against the borehole wall in a lateral plane of expansion of the expandable material. Carroll only discloses two bolts (unnumbered in Figure 2). Carroll, however, provides no support for the examiner's unsupported conclusion that the bolts retain the pad (41) in any way at any point during the operation of the tester. Carroll makes no mention of the bolts performing any action other than attaching the sealing pad (41) to the plate (42). Additionally, as discussed above, Carroll does not teach a retainer wall because the bolts in Carroll do not necessarily retain the sealing pad (41) during operation. There is very easily a scenario where the pad (41) is pressed against the borehole wall without the pad (41) coming in contact with the bolts at all. Also additionally, in real-world operation, the pad (41) coming into contact with the bolts would be a negative as pressing the pad (41) against the bolts would create stress points that would decrease the life of the seal pad (41), not increase it. Thus, if anything, Carroll teaches away from the seal pad (41) coming into contact with the bolts. Regardless, the applicants have amended the claims to indicate more clearly that the retainer is a wall, not bolts as taught by Carroll. Thus, Carroll does not satisfy the requirement of the claims that a retainer wall retain at least a portion of the expandable material in a lateral plane of expansion when sealed against the borehole wall. As such, the applicants respectfully submit that Carroll does not disclose all of the limitations of the claims and requests that the examiner remove the rejection with respect to the claims.

II. CLAIM REJECTIONS - 35 U.S.C. § 103

A. Examiner's Statements

The Examiner rejected Claims 12, 30, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Carroll. The Examiner also rejected Claims 33, 34, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Carroll in view of Hill, et al. (U.S. Patent Application Publication No. 2005/0155760) ("Hill"). The Examiner also rejected Claims 31, 41, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Carroll in view of Fox, et al. (U.S. Patent Application Publication No. 2004/0173351) ("Fox").

B. Law

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.⁷ If the examiner does not produce a *prima facie* case, the applicants are under no obligation to submit evidence of nonobviousness.

To establish a *prima facie* case of obviousness, the following tenets of patent law must be adhered to: (a) the claimed invention must be considered as a whole; (b) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (c) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (d) reasonable expectation of success is the standard with which obviousness is determined.⁸ Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.⁹

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.¹⁰ Thus, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.¹¹ Additionally, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹²

Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.¹³ In addition, if the proposed modification or combination of the prior art would change

⁷ *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

⁸ *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

⁹ *In re Vaack*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

¹⁰ *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

¹¹ *Ex parte Levensgood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *see also In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

¹² *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

¹³ *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.¹⁴

C. Claims 12, 30, 33, 34, 41, 42, 43, and 45

Claims 12, 30, 33, 34, 41, 42, 43, and 45 depend from independent Claims 1, 13, 19, and 35, respectively. The applicants repeat and incorporate by reference the remarks made above with respect to independent Claims 1, 13, 19, and 35. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.¹⁵ Therefore, the applicants respectfully request that the examiner remove the rejection with respect to dependent claims 12, 30, 33, 34, 41, 42, 43, and 45 as well.

III. STATEMENT REGARDING CLAIMS

The applicants comment on the allowability of the claims by addressing the examiner's comments in this paper as well as previously during the prosecution of this application. By doing so, the applicants are in no way limiting their ability to argue additional points of novelty regarding the independent claims or dependent claims at a later date.

CONCLUSION

The applicants respectfully request reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, the applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicants have specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicants may have amended certain claims, the applicants have not abandoned their pursuit of obtaining the allowance of

¹⁴ *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959).

¹⁵ *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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these claims as originally filed and reserve, without prejudice, the right to pursue these claims in a continuing application.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-48300) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,
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